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In the

Supreme Court of the United States.

OCTOBER TERM, 1946.

No. 297.

RUSSELL BOX COMPANY, PETITIONER,

v.

GRANT PAPER BOX COMPANY, RESPONDENT.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

PRELIMINARY STATEMENT.

If one were to accept the statements of the petition, it would appear that Dreymann merely substituted "one wax for another" for its "known properties" and did something as obvious, uninventive and unimportant as substituting porcelain for wood in a doorknob. The salient facts are carefully avoided in the petition and the picture presented does not bear scrutiny.

The sole issue presented by the petition is that of patentable invention.* The test of patentable invention is whether

* Petitioner states (pp. 9–10, par. 5) that if the petition is allowed it will urge that the Court of Appeals erred as to a filewrapper estoppel contention discussed by that court in its first opinion (R. pp. 472, 473). But the petition, (pp. 6, 7) does not include this as a question raised or relied upon for allowance of the writ, and does not discuss it. We therefore see no occasion to discuss this question here.

or not, under all the facts and circumstances, the subject matter displays "more ingenuity . . . than the work of a mechanic skilled in the art" (*Sinclair Co.* v. *Interchemical Corp.*, 325 U.S. 327, 330). "The question whether an improvement requires mere mechanical skill or the exercise of the faculty of invention, is one of fact" (*Thomson Co.* v. *Ford Motor Co.*, 265 U.S. 445, 446). In the present case the finding of fact was reached by the Court of Appeals for the First Circuit after unusually careful and thorough consideration, involving two full hearings.

The District Court did not pass on the issue of invention but went off on a contention of non-infringement by alleged file-wrapper estoppel (R. p. 18). The Court of Appeals in its original opinion (R. p. 465) reversed the District Court on this question, but, believing the case to be governed by the opinion of this Court in the *Sinclair* case, held the patent invalid. The *Sinclair* decision had come down subsequent to the submission of the case to the Court of Appeals.

Respondent (Grant Co.) petitioned for rehearing,* contending that the basis for invalidity in the *Sinclair* case, prior knowledge, was not present in this case, and that the controlling fact situation in the two cases was different in material respects. The Court of Appeals invited written arguments, and after considering them granted the petition (R. p. 487). The case was again fully argued and briefed and the Court of Appeals then held (R. p. 487) that the petition for rehearing was well taken and reversed its original decision, holding claim 3 of the Dreymann patent, the sole claim in issue, valid and infringed.

Except for the unusual consideration given by the Court of Appeals, this is an ordinary patent case with no conflict of decisions between Courts of Appeals and no "special and important reasons" for granting the writ.

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* For Petition for Rehearing see R. p. 476 *et seq.*

Petitioner attempts to procure a further* consideration of this issue of fact by presenting to this Court a petition which disregards the Court of Appeals' correction of error as to prior knowledge on rehearing and carefully avoids any reference to the salient and controlling facts which, as found by the court, distinguish this case from the *Sinclair* case and from those cases wherein, as stated in *Hotchkiss* v. *Greenwood,* 11 How. 248, 266, the substitution is "formal, and destitute of ingenuity or invention".

Petitioner nowhere attempts to show wherein the Court of Appeals was not warranted in finding the true facts indicative of invention.

Petitioner would further conjure up an alleged conflict in rule of law between different circuits by selecting some cases which on different facts reach opposite results, while excluding from consideration cases in the same circuits which, on other facts, reach other conclusions. The basis of the argument is unsound and the alleged conflict is purely fictitious.

The case involves no matter of public importance. Petitioner's effort to find public importance by associating the Dreymann patent with the present food shortage (Pet. p. 21) is rather fantastic.

We turn to the facts.

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* Four times already non-patentable substitution has been urged against Dreymann without effect. The Patent Office rejected on this ground and became satisfied when the facts were presented (Ex. K, R. pp. 405, 419, 425–430). The contention was urged before the District Court which went off on another point and was twice argued to the Court of Appeals without success.

THE ART PRIOR TO DREYMANN.

The petition implies (p. 2 and elsewhere) that prior to Dreymann the art was getting along satisfactorily with existing moisture-vapor proof laminated carton material,* by the use of paraffine and other waxes, and the best that can be said for Dreymann is that he made a slight improvement with just another wax.

The art had long sought ** a satisfactory moisture-vapor proof laminated carton wall for the preservation of food products and the like, but apparently without success. Petitioner never undertook to produce a single sample of any prior art product and there is no evidence that there was ever a successful lamination of paper with any wax prior to Dreymann, or that the products of any of the prior patents could be used commercially.

As we shall presently see, successful lamination involves many factors and obscure problems and far transcends that of merely sticking two sheets of paper or cardboard with some more or less waterproof wax or other agent. The petition cites paraffine as the standard of comparison, but paraffine absorbs into the paper, which makes it impractical for most uses. The prior patentee, Beecher (Appendix, *infra,* p. 21) much relied upon by petitioner, could not prevent such penetration by paraffine and other waxes without using a special non-absorbent glassine paper, which, however, "is very thin . . . not suitable for boxes,

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* The matter of moisture-vapor proof lamination is to be distinguished from that of ordinary waterproof coating, wherein the coating must be non-sticky and penetration is unimportant. Also waterproofing is "something quite different" from prevention of moisture-vapor transfer (R. p. 89). A material may be waterproof and hold water indefinitely, while moisture-vapor will pass through it quite readily (R. p. 89).

** See Johnson No. 229,045 (R. p. 439) granted in 1880 (for further statement as to Johnson see Appendix, *infra,* p. 21).

only for wrapping", for such products as potato chips, etc. (R. p. 467). Indeed, paraffine will not even "stick properly" in lamination (see statement of petitioner's engineer, Sidebottom, R. p. 353).

So far as appears, the only allegedly moisture-vapor proof carton wall that was used commercially prior to Dreymann was an asphalt laminated board (R. pp. 63, 33) called caddy board, put out by one of the larger producers, Robert Gair Co. (R. p. 63), which was the "best moisture proof board" known prior to Dreymann (R. p. 63). But this caddy board was thick, heavy and usable only for large shipping containers, as found by the Court of Appeals (R. p. 467). And its moisture-vapor proof properties as compared with Dreymann were comparatively low (*infra, p.* 8; also Ex. 9, R. pp. 368–9).

Dreymann "overcame the various disadvantages" of the prior art materials previously described or used (R. p. 467), and his advance over Gair's asphalt board, the best the art knew, is striking, as we shall presently see.

We believe no further analysis of the prior art is necessary. Petitioner's analysis is misleading, and the Court of Appeals dismissed the prior patented art as of no importance (R. p. 467; see also footnote, R. p. 488). If the Court is further interested in the prior patents, see Appendix, *infra,* p. 21.

DREYMANN'S INVENTION.

Dreymann, a highly trained chemist (R. p. 466), in 1932 approached respondent, a local box manufacturer of Pittsburgh, with an idea for producing a highly moisture-vapor proof laminated product, suitable for small folding boxes (R. p. 466). Respondent recognized the commercial advantage of such a product, equipped a laboratory for Dreymann, and supplied the necessary venture capital, about $60,000 (R. p. 44). Dreymann's idea was to use as a laminating agent "molten resin, plasticized" (R. p. 120), and his experiments at first proceeded along that line. He had

in the laboratory for use in sealing jars, some commercial amorphous petroleum wax,* which later test showed to contain a native resinous colloid content of about 5% (R. pp. 141; 180–181).

One day, Dreymann dropped some of the commercial amorphous petroleum wax in a melted state on a table, and he noticed a "peculiary behavior of the wax" (R. p. 121). The commercial wax with its trivial resinous colloidal content would not do for laminating. As the Court of Appeals found, it "was almost instantly soaked up and so did not provide an adhesive film, and, in addition, discolored the paper . . . and could not be printed upon" (R. p. 470). Its recognized characteristics for its then prevailing uses made it appear no more adaptable for laminating than rubber or the other waxes. But the "peculiar behavior", found by Dreymann to be due to the presence of some colloid, was fortunately noted by a fertile mind and "patient and skillful scientific research and experimentation" (R. p. 474) lead to important discoveries and the solution of the problem.

The Court of Appeals stated the matter well (R. p. 470):

> "But he [Dreymann] noted that such an amorphous wax as it cooled did not pass almost immediately from a liquid to a solid state, as paraffin does which becomes a firm solid when only two degrees below its melting point, but instead passed from a liquid into a semi-solid or plastic state in which it was very sticky, and then solidified at a temperature approximately five degrees below its melting point. Dreymann realized that this characteristic of the wax was important for laminating purposes so he set about to develop it, and this he found he could do by blending the wax with various resinous colloidal substances foreign to petroleum. In this way he prolonged the plastic stage of

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* This wax had been on the market since 1924 or 1925 (R. pp. 183; 219). Previously it had been largely burned as a waste product (R. pp. 258; 469).

the cooling process, the stage during which the wax was neither a liquid nor a solid and was very sticky, over the time required for the wax to drop about 25 degrees below its melting point. In other words, he found that a resinous colloid in suspension in an amorphous petroleum wax delayed its solidification and gave it increased "tackiness". And this made it suitable for laminating paper, because when the wax, at slightly above its melting point, is spread in a film on a cooler sheet of paper it at once gels (becomes a semisolid, or plastic) and in this condition does not penetrate the paper enough to cause discoloration or to make the paper greasy but instead penetrates the paper only enough to adhere to it, and then remains sticky long enough to permit another sheet of paper to be superimposed, thereby bonding the two sheets firmly and permanently together."

The Circuit Court of Appeals further found (p. 474):

"Dreymann may not be a genius, but nevertheless his mental process in devising the laminated paper described in his patent was inventive. He was aware of the problems inherent in making a relatively thin, moisture-vapor proof, flexible boxboard, and he found a solution for these problems by patient and skillful scientific research and experimentation. Moreover, he made a substantial contribution to the progress of his art as the commercial success of his product and its acceptance by a substantial part of the industry testify."

By providing a substantial gel forming colloidal content (several formulas are given in the patent, R. p. 360) in this particular wax, within a specific range of melting temperature, surprising and unexpected results were discovered, which solved the problem. When in the critical condition, the wax has unique properties. It can be spread in a hot molten state (like hot oil) onto a thin sheet of paper or

cardboard, *but it does not penetrate or soak into the paper*• and does not quickly harden—it forms a non-penetrating gel which continues over a considerable temperature drop below the melting point. In this condition, *it has excessive "tackiness"*, and not only supplies a *"permanent bond"* when the second sheet is laid on, but remains as a *film* or barrier, moisture-vapor resistant to an astonishing degree. As the specification states (R. p. 359, col. 2, l. 10–12), Dreymann discovered a relation between "adhesive power" and "viscosity at elevated temperatures", and, moreover, he found how to put that discovery to use. In lamination the results are new and most valuable. The fragile wax film, in this condition, by this increase in viscosity, becomes adequate not only to stick the sheets together, but to supply a "permanent bond" (R. p. 470)•• and also supplies *an intercalated non-penetrating film or barrier* which is pliable *and though only 1/1000 of an inch thick* (R. p. 123) *is uniform* (no pinholes, R. p. 123) *and 1400% more moisture-vapor proof than asphalt board* (R. p. 63), *the best the art knew prior to Dreymann* (*supra*, p. 5).•••

• All emphasis in this brief is ours.

•• Mere sticking is not enough—the bond must be "permanent" regardless of temperature conditions. Petitioner's engineer, Sidebottom who had worked with paraffine for thirty years (R. p. 353) said but he did not think "paraffine would stick properly . . . simply because it does not have the characteristics of this wax" (R. p. 353). It would not "be a commercial product" (R. p. 354). See also the testimony of Sidebottom that the gel on cooling for a period between the solid and liquid phases is essential to petitioner's laminating operation (R. p. 353). Sidebottom also testified to the importance of a "film" as well as a bond (R. p. 357), as defined in claim 3.

••• As might be expected, Dreymann's new product was highly successful commercially, "due to the intrinsic merit of the product and not to advertising or the plaintiff's business methods (R. p. 467). Respondent has freely granted licenses (R. p. 45) and at the time of trial, November 1943, 60% of the boxboard of this type was produced under the Dreymann patent (R. p. 474).

As to the result, the Court of Appeals found that it can be said of Dreymann as of Cummings, in *Smith* v. *Goodyear,* 93 U.S. 486, that the result of his teaching "was a new product differing from all that preceded it, not merely in degree of usefulness and excellence, but differing in kind, having new uses and new properties" (R. pp. 488–489).

NO PRIOR KNOWLEDGE.

THE SINCLAIR CASE.

Petitioner felt obliged to refer to the *Sinclair* case and asserted (p. 7) as a reason for allowance of the writ that the present decision is "probably in conflict with the applicable decision" in the *Sinclair* case. But it is notable that petitioner nowhere undertakes to advance any reason, analysis or argument in support of this bare assertion, and nowhere undertakes to show wherein the Court of Appeals was in error in its final opinion.

Our petition for rehearing (R. p. 476) to which we refer this court, states our position as to the *Sinclair* case. We there showed that the Court of Appeals was in error in its first opinion in believing that there was prior knowledge which made applicable the time honored doctrine of the *Sinclair* case that prior knowledge invalidates. In that case the patentee, Gessler, merely followed the instructions of a prior publication of Hanson.

The court summarized the differences between the present case and the *Sinclair* case as follows (R. p. 488):

> "Dreymann . . . did not merely play Gessler to some prior worker's Hanson. He combined the roles of Hanson and Gessler in that he not only discovered the essential characteristics which a laminating agent for paper ought to have to accomplish the purpose he had in mind, but he also found the agent."

Petitioner nowhere attempts to show wherein the Court of Appeals was in error.

THE PETITION AVOIDS THE SALIENT FACTS AND IS BASED ON A FALSE PREMISE.

The salient and controlling facts briefly outlined above are completely avoided in the petition. The petition would have it that Dreymann merely used a "better" wax, utilizing the "well known properties" of such wax, whereby there was a mere "substitution of materials, without more". Or, as stated (Pet. p. 10), "Dreymann's invention was only the substitution of one wax for another in an old combination".

This basic assumption of the petition is erroneous, as we have shown, and is contrary to the facts found by the Court of Appeals. The court found that Dreymann made important discoveries which were the touchstone to success.

The petition nowhere contends that the court's findings were in any way in error or that the court was not warranted in finding that the facts relied upon are indicative of invention.

Instead, the petition sets up a strawman of mere formal substitution, without more, and would thereby contend that the court erred as a matter of law in ruling that a mere formal substitution constitutes patentable invention. The court made no such ruling.

THE SUBSTITUTION OF MATERIALS CASES. THE ALLEGED CONFLICT OF LAW IS PURELY FICTITIOUS.

Petitioner's erroneous picture of the facts of the Dreymann invention is accompanid by a laborious effort to conjure up an alleged conflict of law between the First and Second Circuits on the one hand and the Third and Seventh Circuits on the other hand as to the rule of law relating to substitution of materials (Pet. p. 14).

This shows a complete misconception of the cases and of their bases. Uniformity cannot exist unless the facts in all the cases are the same. They are not.

Petitioner has selected a few cases which, on different

facts, reach opposite results and, moreover, has not cited the cases in the same circuits, which on their particular facts, reach other results.

As has been said by others, "invention is always a function of the particular situation, of the conditions which preceded and followed the appearance of the composition or machine". This is the point of view recognized by the circuits in question, as well as by this Court.

Substitution of materials may or may not involve invention, depending on the circumstances of the particular case, and there are no conflicting rules of law in the circuits in question or elsewhere.

In *Hotchkiss* v. *Greenwood,* 11 How. 248, Hotchkiss merely used porcelain instead of wood in a particular doorknob combination, where doorknobs of porcelain were old. The *Hotchkiss* case does not rule that a substitution cannot be invention, as this Court pointed out in *Smith* v. *Goodyear,* 93 U.S. 486, 494.

In *Hicks* v. *Kelsey,* 18 Wall. 670, Hicks, the patentee, was expected to know that iron is stronger and more durable than wood, and therefore would be useful where strengthening is desired, as in a wagon reach.

These classic cases are examples of what is generally termed mere formal substitution of materials, of which there are many cases, some of the leading ones in this Court being cited in the petition.

In such cases there is no invention because there is "no ingenuity" beyond that of the skilled man. For the same reason there is no invention in the mere double use of an old expedient, as in such cases as *Atlantic Works* v. *Brady,* 107 U.S. 192, *Cuno Corp.* v. *Automatic Corp.,* 314 U.S. 84, *Altoona Theatres* v. *Tri-Ergon Corp.,* 294 U.S. 477, and *Dow Chemical Co.* v. *Halliburton Oil Co.,* 324 U.S. 320.

We are in accord with the petition and the cases in condemning an effort to monopolize a mere formal substitution or double use.

Where the courts, as triers of fact, have found that the patentee has done more than apply familiar knowledge with no unexpected result, and has contributed to useful knowledge by the exercise of "more ingenuity . . . than the work of a mechanic skilled in the art", patentability has been found in substitution as in other cases.

In *Smith* v. *Goodyear,* 93 U.S. 486, this Court was satisfied from the facts of the case that "what Cummings accomplished was more than a substitution of one material for another; more than the exercise of mechanical judgment and taste" (p. 495). The petition finds no fault with this decision.

See also *Potts* v. *Creager,* 155 U.S. 597, 608, 609, cited with approval in *Goodyear Co.* v. *Ray-O-Vac Co.,* 321 U.S. 275, 279.

In *Celluloid Mfg. Co.* v. *Frederick Crane Chemical Co.,* 36 Fed. Rep. 110, Justice Bradley, who delivered the opinion in *Hicks* v. *Kelsey* (*supra*), sitting with the Circuit Court of New Jersey, after discussing the *Hotchkiss* and *Hicks* cases, said (p. 112):

> "There is no rule of law that the substitution of one material for another is not patentable. In processes of manufacture, and in compositions of matter, such a substitution often effects material changes in the result, either as to the product or the expense."*

The petition does not deny that an improvement which can be said to reside in substitution may involve invention.

In the present case, the Court of Appeals for the First

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* For a good statement see *Remington Rand* v. *Acme Co.,* 71 F. (2d) 628, 632 (C.C.A. 4th);

> "There is, however, no rule of law that the substitution of a new material for an old is not patentable. The question is always whether the alteration requires invention or merely the exercise of mechanical skill and judgment. The answer must be found in the light of the circumstances of the particular case. . . ."

Circuit did not rule that a mere substitution of materials is invention and there is no such rule of law in that circuit or in any other circuit, as far as we are aware. The court was satisfied on all the evidence that Dreymann had not merely substituted "one wax for another" but by the exercise of unusual skill had made a *new* discovery of value and importance.

Where that court has found that the patentee has merely applied existing knowledge as may be expected of the skilled man, it has consistently denied patentability (for more recent cases *Dorr Co.* v. *Yabucoa Sugar Co.*, 119 F. (2d) 521; *Nichols* v. *Sanborn Co.*, 124 F. (2d) 654; *Grosjean* v. *Panther-Panco*, 113 F. (2d) 252; *Mabey* v. *Howard*, 132 F. (2d) 40; *Bellavance* v. *Frank Morrow Co.*, 140 F. (2d) 419).

In the Second Circuit, there is no rule of law that a mere substitution of materials is invention. In *United Shoe* v. *E. H. Ferree Co.*, 64 F. (2d) 101, the Court, recognizing (p. 103) that "the facts of each case must determine" the issue, found the facts highly persuasive that the patentee had done something more than merely substitute a material for its known properties. He solved an old problem, the solution of which had evaded the art for years, by completely reversing the whole trend of the art with a revolutionary suggestion that was considered "impractical and impossible". There were facts beyond the mere substitution which the Court considered persuasive of unusual ingenuity and patentable invention.

Smokador Mfg. Co. v. *Tubular Products Co.*, 31 F. (2d) 255, involved something more than a substitution of glass for metal in the bottom of a cigar ash receptacle. The court (p. 256) defines the invention as comprising the substitution of glass "for a prior, and what we may justly regard as a more obvious, form of container, and to shield it from sight, except when the stand is turned up for examination". The protecting and shielding skirt was an element of the combination claim (see 27 F. (2d) 948, 949).

Where there is a mere formal substitution or judicious selection, utilizing known properties with expected results, the Court of Appeals of the Second Circuit is in accord with other circuits and with this Court, that no invention is involved although reaching an improved result. For more recent cases see *Aero Co.* v. *Beaver Co.*, 97 F. (2d) 363, 365; *Minton Mfg. Co.* v. *Continental Briar Pipe Co.*, 93 F. (2d) 271; *Johnson Metal Products Co.* v. *Lundell-Eckberg Mfg. Co.*, 98 F. (2d) 756, 758; *Condenser Corp.* v. *Davega-City Radio*, 108 F. (2d) 174; *Trubenizing Process Co.* v. *Jacobson*, 98 F. (2d) 899.

The Third and Seventh Circuit cases cited in the petition to show an alleged different rule of law are cases of the merest and most obvious substitution and nothing more.

In *Fowler* v. *Honorbilt Products*, 131 F. (2d) 153 (C.C.A. 3d), the patentee made a better upholstery padding by substituting sisal for cotton. The improvement was "due alone to the fact that the peculiar properties and characteristics of sisal rendered it superior for padding purposes in upholstery—a fact which had long been widely known and understood" (p. 155).

The Third Circuit has no rule of law in conflict with any rule of the First and Second Circuits. When the facts and circumstances show that the patentee has contributed to the sum of human knowledge, has gone beyond the mere intelligent selection of materials for their known qualities, there may be invention in substitution, depending on the facts.

In *Allen Filter Co.* v. *Star Metal Co.*, 40 F. (2d) 252, the Court of Appeals for the Third Circuit sustained the Mull patent for water cooler coils made of resilient metal instead of inert metal, as in the prior art. The court recognized that, "It is, of course, too well settled to be now open to question that the mere substitution of one material for another in an old article is not invention, notwithstanding the substituted material may be better for the purpose."

But the special facts of the case showed that the substitution was not obvious, that the use of resilient metal was not the result of judgment in the selection of materials, and that "its adaptability for the purpose was not obvious." Petition for certiorari was denied (282 U.S. 848).

For a more recent case, where the Court of Appeals for the Third Circuit sustained a patent involving substitution of material, see *Gilbert Spruance Co.* v. *Ellis-Foster Co.*, 114 F. (2d) 771. In this case the patentee substituted a certain synthetic resin for other resins in a lacquer compound, with greatly improved results. As the court said (p. 773) in words applicable to Dreymann's contribution, "he seized upon a thing which was available to all but which had been grasped by none, and was able to fit it into a new place, to create an original and useful result. . . . The case at bar presents an almost classic example of new use."

In *Lafferty Mfg. Co.* v. *Acme Ry. Signal & Mfg. Co.*, 138 Fed. Rep. 729 (C.C.A. 7th), there were no facts showing invention. Paper was substituted for tin in a cap of a torpedo. There was no solution of a problem and no advance in the art. The only merit of the change was a decrease in cost, and the court considered that under the facts of the case, "The mere fact that the cost of the article to the public is thereby cheapened does not give to the substitution of one material for another the quality of patentable invention".

There is no conflict here with the decision in the present case.

Angier v. *Nehring Elec. Works*, 45 F. (2d) 354 (C.C.A. 7th), involved the use of crepe paper for wrapping tires. The use of crepe paper for wrapping purposes was old and familiar practice. As the court said, "Every element of the patented 'package' is venerably old." This was a clear case of the merest double use, and there were no facts whatever to sustain invention.

This case is not in conflict with the present decision.

Where the patentee discovered attributes of a known alloy in certain proportions, applicable and useful to a particular use, the Court of Appeals for the Seventh Circuit did not hesitate to find patentability in the substitution of such alloy as an electric resistance element (*General Electric Co.* v. *Hoskins Mfg. Co.*, 224 Fed. Rep. 464).

There is no conflict in rules of law, as alleged. The divergent results, stressed by petitioner, arise solely from divergent facts.

The decision of the Circuit Court of Appeals in the present case is not in conflict with any of the decisions cited, including those of this Court. In the present case and in all the cases cited the decision on the question of invention is necessarily and intimately bound up with and dependent upon the facts in the particular case.

The alleged conflict in rule of law is purely fictitious.

DREYMANN'S INVENTION SATISFIES PETITIONER'S OWN TEST.

The petition vacillates between urging on the one hand (Point III, Pet. p. 19) that no patent involving substitution should be sustained and elsewhere conceding that such patents may be valid and then undertakes to reduce the test of invention where the improvement can be said to reside in a substitution of materials, to a formula of words or to abstract general definition, whereby the fact of invention becomes a matter of terminology. It is petitioner's position (Pet. p. 15) that as a matter of law, if the improvement can be said to comprise a substitution of materials, there is no invention, unless there is a "new contrivance, relationship of elements, or new process".

While we question that there are any such absolutes, or that such phrases or labels are useful as abstract defini-

tions,* nevertheless, on petitioner's own ground, Dreymann's invention is not a mere substitution of materials, but fully satisfies the alleged requirement of the phrase "new contrivance" or "new relationship of elements". The very essence of Dreymann's invention resides in a new and highly useful "contrivance". We quote, *supra,* p. 9, the finding of the Court of Appeals, nowhere challenged by petitioner, that Dreymann's teaching, like that of Cummings in *Smith* v. *Goodyear,* resulted in a "new product differing from all that preceded it, not merely in degree . . . but *differing in kind, having new uses and properties*". And, moreover, this new result or "contrivance" is due to a "new relationship of elements" as above described, arising from Dreymann's discovery.

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* See the impressive statement of Judge Learned Hand in *Van Heusen Products* v. *Earle & Wilson,* 300 Fed. Rep. 922, 929. As to substitution of one material for another, he observed:

> "I do not conceive that the law has ever laid down any such absolute rule on this subject, or any other absolutes for that matter. . . . Is it not clear that the quality of a man's inventiveness must be tested by reconstituting the situation as it was in the light of the preceding history of the art? There is no *vade mecum* for such inquiries. Our unknown ancestor, who first substituted iron for bronze in the head of an ax, was the bright exemplar of all inventors to come. . . . In this subject the standard escapes any abstract definition, because the end in view needs nicer adaptations, as in the cases of due care or notice."

This Court said in *McClain* v. *Ortmayer,* 141 U.S. 419, 427:

> "Whether the variation relied upon in a particular case is anything more than ordinary mechanical skill is a question which cannot be answered by applying the test of any general definition."

MISCELLANEOUS COMMENT.

We see no relevance to petitioner's point III (p. 19). In *Bassick* v. *Hollingshead,* 298 U.S. 415, this Court held that as the combination of pump, connecting conduit, coupler, and fitting was old, Gulborg could not by inventing a new type of fitting reclaim the old combination *per se,* but must be confined to the new fitting itself. The Court did not hold that a *new combination* cannot be patentable even though all the elements be individually old. We see no pertinency in this decision, and if petitioner's suggestion in this regard should be adopted, as a new rule of law, invention could never be predicated on a new discovery, however revolutionary, that a particular material can be adapted to a new use for the production of a vastly superior product, however unexpected the result.

As to the standards of invention, the Court of Appeals of the First Circuit has specifically recognized the "far higher" standards now prevailing (see *Brown & Sharpe* v. *Kar,* 154 F. (2d) 48, 51–52, handed down while the decision on rehearing in the present case was under advisement).

Petitioner asserts (p. 3) that it merely purchased some amorphous petroleum wax on the market and used it. The petition for rehearing (R. pp. 480–483), sets forth some of the facts of records as to petitioner's infringement *following* extensive commercial use by respondent and the issue of the Dreymann patent. Petitioner does not use commercial wax or any run of the mill wax but a special brew which accounts for its special characteristics and qualities (p. 326). Petitioner, unable to use a commercial wax, blends with commercial wax some petrolatum (R. pp. 300–301) which contains a substantial amount of resinous colloid and thereby builds up the necessary colloidal content. The resulting product contains 25% of resinous colloid (R. p. 471). This special blend was considered a "trade secret" (R. p.

302) and, by agreement, was sold by the blender to no one else for laminating (R. p. 113).

As to the new Dean affidavit (Pet. p. 23), the accuracy of which has not being tested, it does not appear how much of his estimated amount of amorphous petroleum wax is to be doctored for use in making laminated products of the Dreymann invention. If all or any substantial percentage is to be so used by respondent and its licensees or in infringement, Dreymann has indeed created a new and very large industry. The petrolatum base of amorphous petroleum wax has been long used as "Vaseline" (R. p. 92), and the wax by-product, until recently, for the most part has been burned as a waste product (R. pp. 258; 469). Dreymann has apparently succeeded in transforming millions of pounds of waste product to a valuable use.

The effort to use the food shortage has been referred to, *supra,* p. 3. Nor do we believe, as the petition (p. 21) seems to urge, that because Dreymann's invention is useful in packaging foods petitioner should be free to appropriate it, regardless of the patent law enacted by Congress, without taking a license as others have done.

CONCLUSION.

We submit the grounds set forth for further review by this Court do not bear scrutiny. The Circuit Court of Appeals has committed no reversible error, has applied no law at variance with the law of this Court or that of other circuits, and there is no conflict of law in different circuits to be resolved.

There is here no reason for review that cannot be advanced by any defeated party in a patent case who is not satisfied with the decision of the lower court on the issue of patentable invention, a contested issue in substantially every patent suit.

Respectfully submitted,

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APPENDIX.

THE PRIOR PATENTS.

Johnson of 1880 (No. 229,045, R. p. 439) proposed a laminated wrapping paper using an intercollated layer of paste made of a compound of caoutchouc and paraffine. Paraffine is a familiar wax, long used for waterproof coating and proposed for lamination. But when it solidifies it is brittle (R. pp. 184; 277), and when applied in a molten state, as for lamination, will absorb into the paper or cardboard like ink into a blotter and moreover is not sufficiently adhesive (*supra*, p. 5).

Beecher, No. 1,936,375 (R. p. 448) specified paraffine "or other mineral, animal or vegetable waxes" as a laminating agent, between sheets of glassine paper (R. pp. 266; 467), a special non-absorbent paper which Beecher used to prevent absorption or impregnation of "ordinary paper", which he realized would become impregnated with his wax (R. p. 449, line 53). Beecher saw no way of preventing penetration or absorption of the wax into the paper except by using glassine paper. Glassine is "expensive . . . and very thin . . . not suitable for boxes, only for wrapping" potato chips and the like (R. p. 467). It does not appear that Beecher was ever used.

Fietsch, No. 1,269,918 of 1910 (R. p. 456), much relied upon by petitioner, as early as 1910 was trying to make some use of petroleum residuum as a laminating moisture resistant agent for paper boxes. His proposal was to use a laminating layer of "oxidized petroleum residuum" formed by blasting such residuum "with air at high temperature". As the testimony showed (R. p. 280) and as the Court of Appeals found (R. p. 467), Fietsch's process produced "air blown asphalt". The petition (p. 10) is misleading as to Fietsch.

The other prior art patents cited by the petition are of no significance.*

* Hoch (R. p. 443) was concerned with impregnating an electrical condenser material for waterproofing. McLaren (R. p. 445) had no concern with laminating and proposed no use for his material, and no one ventured to testify that it could be used for lamination. McLaren was apparently concerned with the wax for its then established common uses, emulsifying, sizing and impregnating (R. p. 83). Rose (R. p. 453) was concerned with coating and impregnating. Pearsall (R. p. 451) was concerned with a "non-tacky" coating.

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No. 387.

RUSSELL BOX COMPANY,
Petitioner,

v.

GRANT PAPER BOX COMPANY,
Respondent.

MOTION
AND
BRIEF IN SUPPORT OF ALLOWANCE OF PETITION
BY RUSSELL BOXFORD COMPANY TO FILE BRIEF AS AMICUS CURIAE.

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